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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,838	10/03/2008	Niels Ebbe Jacobsen	P3593US00	8747
36671 7590 10/19/2010 DITTHAVONG MORI & STEINER, P.C. 918 Prince Street Alexandria, VA 22314				
EXAMINER NGUYEN, DAVID Q				
ART UNIT		PAPER NUMBER		
2617				
NOTIFICATION DATE		DELIVERY MODE		
10/19/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@dcpatent.com

# Office Action Summary

**Application No.**

10/583,838

**Applicant(s)**

JACOBSEN ET AL.

**Examiner**

DAVID Q. NGUYEN

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 8, 16, 19-35, 37 and 40-57 is/are pending in the application.
- 4a) Of the above claim(s) 28-34, 37 and 50-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 8, 16, 19-27, 35 and 40-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed 08/18/2010 have been fully considered but they are not persuasive.

Applicant's election with traverse of group I, claims 1, 8, 16, 19-27, 35, and 40-49 in the reply filed on 08/18/2010 is acknowledged. The traversal is on the ground(s) that the claims of the present application include Group I: a user terminal querying a server for presence information of registered user(s) and Group II: the server processing the queries. The corresponding claims of the two groups appear significantly overlap. Accordingly, Applicants respectfully traverse the outstanding Restriction.

This is not found persuasive because inventions I and II are unrelated. Invention I, claims 1, 8, 16, 19-27, 35, and 40-49, drawn to a user terminal generating one or more inquiries about one or more users are registered with a service and selecting one or more the registered users to receive presence information, classified in class 455, subclass 407. And Invention III, claims 28-34, 37, and 50-57, drawn to a server receiving one or more inquiries about one or more users are registered with a service and receiving a request to receive presence information of one or more of the registered users, classified in class 455, subclass 408. They are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. Each invention is required a different search in a different classification.

The requirement is still deemed proper and is therefore made FINAL.

Applicant's arguments with respect to claims 1, 8, 16, 19-27, 35, and 40-49 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 8, 19-27, 35 and 40-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahn et al. (KR 2002074304 A).

Regarding claims 1, 19, 24 and 35, Ahn et al. disclose a communication system, an apparatus comprising:

at least one server for providing a service and storing identities of users registered to the service; and at least one user terminal wherein the user terminal comprising: at least one processor; and at least one memory including computer program code for one or more programs, the at least one memory and the computer program code configured to, with the at least one processor, cause the apparatus to perform at least the following, generate one or more inquiries about whether one or more users are registered with a service (see abstract; the member searching for a friend by inputting the ID, the name and the phone number of the friend in a friend searching menu); receive a reply indicating which of the one or more users is registered (see abstract; the messenger server updating data on the registered friend group by using paging method, the member checking a state or situation of the registered friend); and selecting one or more of the registered users to receive presence information of the selected one or more users (see abstract; the member selecting one among menus of an ID, a phone call).

Regarding claim 8, Ahn et al. disclose wherein each user terminal is a client terminal and the communication system operates in a client-server mode, and the client terminal is arranged to communicate with the server using at least one of a client-server protocol (CSP) and a command line protocol (see abstract).

Regarding claim 20, Ahn et al. disclose wherein the apparatus is further caused to: present at least one command option via a user interface; and in response to selection of the command option, transmit the one or more inquiries to the service (see abstract).

Regarding claim 21, Ahn et al. disclose wherein the apparatus is further caused to: select one or more of the registered users to subscribe to presence information of the selected one or more users (see abstract).

Regarding claim 22, Ahn et al. disclose wherein the apparatus is further caused to: store a plurality of identities of other users of a network that supports substantially real-time communications between the selected users (see abstract).

Regarding claim 23, Ahn et al. disclose wherein the service comprises an instant messaging and presence service (IMPS) server which supports one or more wireless instant messaging services, presence services, or a combination thereof between the selected users (see abstract).

Regarding claim 26, Ahn et al. disclose selecting one or more of the registered users to subscribe to presence information of the selected one or more users (see abstract).

Regarding claim 27, Ahn et al. disclose determining to transmit one or more wireless instant messages, one or more presence data between the selected users (see abstract).

Regarding claim 40, Ahn et al. disclose wherein the apparatus is further caused to: store one or more identities corresponding to the one or more users; receive the presence information; and present at the apparatus the presence information with user identities of the selected one or more users (see abstract).

Regarding claim 41, Ahn et al. disclose wherein the apparatus is further caused to: present at least one command option via a user interface thereof; and in response to selection of the command option, mark one or more of the registered users to receive the presence information thereof (see abstract).

Regarding claim 42, Ahn et al. wherein the apparatus is further caused to: present at least one command option via a user interface thereof; and in response to selection of the command option, mark one or more of the registered users to subscribe to the presence information thereof (see abstract).

Regarding claim 46, Ahn et al. disclose determining to store one or more identities corresponding to the one or more users; determining to receive the presence information; and determining to present at the user terminal the presence information with one or more user identities of the selected one or more users (see abstract).

Regarding claims 43-45 and 47-52, Ahn et al. disclose wherein the presence information includes at least one terminal availability, user status, user location, user device capability, user moods, user interest, or a combination thereof (see abstract); wherein the user terminal communicates with the service using at least one of a client-server protocol (CSP) and a command line protocol (see abstract); wherein the service is an instant messaging and presence service (see abstract); wherein the service is an instant messaging and presence service (see

abstract); wherein the service is interoperable with one or more instant messaging services, one or more presence services, or a combination thereof (see abstract); wherein the service operates under an IMPS protocol suite at an application level (see abstract).

3. Claims 18 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn et al. (KR 2002074304 A) in view of Mathis (US 2003/0083046 A1).

Regarding claim 18, Ahn et al. do not disclose wherein the server transmits substantially instant messaging between the at least one user terminal and a second user terminal, both of the user terminals sending transmit presence data representing the status of respective users to the server in an asynchronous manner, and the server is arranged to, on receiving that data, store that data, and subsequently, in response to the receiving a request from the at least one user terminal for the presence data of the second user terminal, to transmit the stored presence data of the said second terminal in a substantially instant manner to the at least one user terminal. Mathis discloses wherein the server transmits substantially instant messaging between the at least one user terminal and a second user terminal, both of the user terminals sending transmit presence data representing the status of respective users to the server in an asynchronous manner, and the server is arranged to, on receiving that data, store that data, and subsequently, in response to the receiving a request from the at least one user terminal for the presence data of the second user terminal, to transmit the stored presence data of the said second terminal in a substantially instant manner to the at least one user terminal (see pars. 0010-0012 and 0019). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Mathis to Ahn et al. so that user can invite another user or player to attend the chat room or play game each other.

Regarding claim 25, Ahn et al. do not disclose determining to present at least one command option via a user interface at the user terminal; and in response to selection of the command option, determining to transmit the one or more inquiries to the service receiving a result message indicating the identities of other users that are registered to the server. Mathis discloses determining to present at least one command option via a user interface at the user terminal; and in response to selection of the command option, determining to transmit the one or more inquiries to the service receiving a result message indicating the identities of other users that are registered to the server (see pars. 0010-0012 and 0019). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Mathis to Ahn et al. so that user can invite another user or player to attend the chat room or play game each other.

### *Conclusion*

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID Q. NGUYEN whose telephone number is (571)272-7844. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jinsong Hu can be reached on (571)272-3965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David Q Nguyen/  
Primary Examiner, Art Unit 2617

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